

REMARKS/ARGUMENTS

Favorable reconsideration of this application is respectfully requested in view of the amendments made above and the remarks that follow. A petition for a one-month extension of time to and including January 13, 2006, is submitted herewith.

The indicated allowance of claims 3, 9 and 10, and the indicated allowability of claims 5-8 subject to being rewritten to include the subject matter of the base claim and any intervening claims is noted and appreciated.

While the indicated allowance of claim 3 is appreciated, the subject matter of that claim was incorporated into claim 1 in the previous amendment and applicant intended to cancel claim 3, but inadvertently neglected to do so. Since all the limitations of claim 3 were included in claim 1 by the amendment previously made, and the examiner considers claim 3 to be allowable, then claim 1 as previously amended should also be allowable. Accordingly, claim 1 as previously amended has been rewritten as new claim 11 submitted herewith. For the reasons stated, new claim 11 should be allowable.

Previous claim 1 has been retained and further amended in this paper so that the preamble properly comprises a structural limitation of the claim. The preamble of the claim as now amended is more than a mere statement of purpose or intended use. Instead, it gives life and meaning to the claim, and when read in the context of the entire claim comprises a structural limitation of the claim. See MPEP 2111.02. *“If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is ‘necessary to give life, meaning, and vitality’ to the claim, then the claim preamble should be construed as if in the balance of the claim.”* Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir.1999). And, in Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951), the court stated: *“A preamble reciting ‘An abrasive article’ was deemed essential to point out the invention defined by claims to an article comprising abrasive grains and a hardened binder and the process of making it. The court stated ‘it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as an abrasive article. Every union of substances capable inter alia of use as abrasive grains and a binder is not*

an 'abrasive article.' Therefore, the preamble served to further define the structure of the article produced". The preamble in claim 1 as now amended calls for a swimming pool skimmer guard with attaching means for attaching the guard to the wall of a swimming pool. These limitations are structural limitations of the claim. Further, this language is essential to an understanding of the scope of the claim and what is intended to be covered by the claim. See Kropa v. Robie, *supra*.

None of the patents of record disclose or suggest a swimming pool skimmer guard having attaching means for attaching the guard to the wall of a swimming pool in stationary position across a skimmer opening, and that is flexible or bendable so that it can be adjusted to fit different size skimmer openings.

The device disclosed by Ali (5,623,787) is a specialized device for placement in the valley of a tile roof. It is flexed into a U-shape and the opposite "legs" thereof are inserted and held between opposed rows of roofing tiles to hold the guard in place. The Ali device does not have attaching means for attachment of the guard to the wall of a swimming pool and it is not capable of functioning as a swimming pool skimmer guard. There is no suggestion in Ali of using the guard as a swimming pool skimmer guard, or of how the guard could be attached to a wall of a swimming pool, or of how the guard of Ali could be adapted to such use. Accordingly, the rejection of claims 1 and 4 (especially as now amended) as obvious in view of Ali under 35 USC 103(a) should be withdrawn.

To establish obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In order to adapt the device of Ali or any of the other references of record to make them capable of functioning as a swimming pool skimmer guard as now claimed would require

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Responds of Office Action of September 13, 2005

substantial modification and would change the principle of operation of those devices, making them unsatisfactory for their intended purpose.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, or require a substantial reconstruction and redesign of the elements shown in the primary reference, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 122 USPQ 349 (CCPA 1959).

If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

It is respectfully submitted that rejection of the currently amended claims as obvious in view of Ali would not be in compliance with applicable law, and the claims as now amended should be allowed.

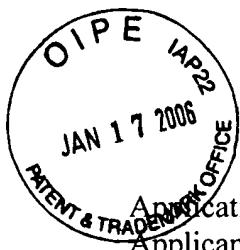
Respectfully submitted,
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : **10/660,961**
Applicant : **Alan GEORGEFF and Louis PAPER**
Filed : **09/12/2003**
Title : **GUARD FOR SWIMMING POOL SKIMMERS**

Docket No. : **57183**

CERTIFICATE OF MAILING

Commissioner of Patents
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Alexandria, Virginia 22314-1450

Dear Sir:

I, Christine A. Lambert, hereby certify that the following attached documents: Amendment; Extension Request; check in amount \$60.00 along with a first-class postage prepaid return receipt card, are being deposited today, January 12, 2006, with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to:

Commissioner of Patents
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January 12, 2006

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